REMARKS

Claims 1-14 are all the claims pending in the application. By this Amendment, Applicant amends claims 1 and 8. Claims 1 and 8 have been amended solely for the purpose of correcting minor error. Since such amendments are made to correct minor, basic elements, Applicant respectfully submits that that they do not narrow the scope of the claim and do not raise any Festo implications.

Preliminary Remarks

The Examiner reminds the Applicant that it is Applicant's responsibility to ensure that the drawings are corrected in accordance with instructions set forth in the previous office action of April 30, 2003. Applicant thanks the Examiner for the reminder. However, Applicant respectfully submits that the drawings filed on September 20, 2000 are accepted as indicated in the present office action, PTO form PTOL-326 and the previous office action of April 30, 2003. Therefore, this reminder is inapplicable to the present application.

Rejection under 112

In addition, the Examiner rejected claims 1-5 and 8 under section 112, second paragraph for including phrase "such as" in claims 1 and 8. Applicant thanks the Examiner for pointing out, with particularity, aspects of the claim thought to be indefinite. Applicant respectfully requests the Examiner to withdraw this rejection in view of the self-explanatory claim amendments, being made to claims 1 and 8, herein.

Rejection under 103(a)

The Examiner rejected claims 1-14 under 35 U.S.C. § 103(a) as being unpatentable over

USP 6,449,272 to Chuah et al. (hereinafter "Chuah") in lieu of obviousness. Applicant

respectfully traverses this rejection and respectfully requests the Examiner to reconsider this

rejection in view of the comments, which follow. Of these rejected claims, claims 1, 6, 8 and 10-

13 are independent. Applicant will first address this rejection with respect to claim 1.

Independent claim 1 recites a novel combination of features. For example, claim 1

recites: ...*notifying said second user-terminal based on said request of communication from said*

first user terminal; and switching said second user terminal from said second virtual private

network to said first virtual private network...From hereinafter, this recited limitation will be

referred to as "switching to a different virtual private network the user terminal to which a

request is made" for the sake of linguistic convenience only.

The Examiner asserts that claim 1 is directed to a method of connecting a first user

terminal of a first virtual private network to a second user terminal of the second virtual private

network and is obvious in view of Chuah. The Examiner asserts that Chuah's switching ISP

providers (serving LACs) for a PC renders obvious switching a user terminal to which a request

for connection has been made, to a different virtual private network as set forth in claim 1 (see

pages 3-4 of the Office Action). Applicant respectfully disagrees with the Examiner. Applicant

has carefully studied Chuah's discussion of establishing a connection with a VPN via anchor

LAC and the hand-off procedure (switching to a different serving LAC), which does not teach or

even remotely suggest switching to a different virtual private network the user terminal to which

a request is made as set forth in claim 1.

For example, an illustrative, non-limiting embodiment of the present invention teaches

switching a user terminal from a first virtual private network ("VPN") to a second VPN by using

information stored in the subscriber server data. The subscriber data server (SDS) receives

requests to connect to a second user terminal from the first user terminal via network access

server (NAS), searches in the database for the recent registration information of the second user

terminal. In particular, it checks to see which NAS is connected to the second terminal and to

which VPN the second terminal belongs. Then, it notifies the second user terminal about the

incoming call. The second user terminal decides whether to accept the call or not. If this second

terminal decides to accept the call, it is switched to the VPN of the first user terminal; thereby,

allowing the first user terminal to access the second user terminal via VPN. Finally, the

registration information in the SDS is updated.

On the other hand, Chuah teaches a method of switching remote user to a different

Internet Service Provider (ISP) without loosing previously established VPN connection (col. 1,

line 55 to col. 2, line 12). In particular, Chuah teaches a remote user initiating a point to point

connection to the serving LAC (NAS) in ISP B. ISP B authenticates the user and accepts the

connection (Fig. 2; col. 3, lines 50 to 65). Next, in order to establish the VPN, the serving LAC

checks its VPN table which has an association between users and anchor LACs (another NAS)

and identifies anchor LAC associated with this user. Once the anchor LAC is identified, a tunnel

is established between the service LAC and the anchor LAC provided there are no existing

tunnels between the two LACs (Fig. 2; col. 4, lines 12 to 60).

Once the tunnel is established, serving LAC forwards a VPN request along with user

information to the anchor LAC. Anchor LAC identifies the associated LNS (corporate network

server that provides VPN) and establishes a VPN session (Fig. 3; col. 4, line 65 to col. 5, line

62). This multi-hopping technique is especially beneficial for establishing VPN from a cellular

phone (its location may change to a different geographical area; thereby, resulting in a VPN

session being drop). Specifically, PCS wireless network detects the need for a hand-off and

provides the new LAC with a notification of an impending hand-off. The new LAC identifies

the anchor LAC, establishes the connection with the anchor LAC and sends a continued call

request message to the anchor LAC. The anchor LAC recovers information about the terminal

and its connection to the VPN network; thereby, allowing the transfer of the existing connection

to the new LAC (Fig. 10; col. 9, line 33 to col. 10, line 48).

To sum up, Chuah teaches having a serving LAC and an anchor LAC, which stores

information about VPN sessions. If a switch of serving LACs needs to be made, the new serving

LAC identifies the anchor LAC to get information about the current session and establishes a

link to the current session. As a result, this arrangement prevents the drop off of the VPN

connection (instead the connection is continued through a new serving LAC).

However, in Chuah, there is only one VPN. That is, Chuah teaches maintaining the same

VPN while changing ISPs. In particular, Chuah teaches switching ISPs to maintain a link to the

same VPN. Although one tunnel, the tunnel from a serving LAC to an anchor LAC; is changed,

the tunnel from the anchor LAC to the VPN is the same.

The purpose of Chuah is to maintain access to the same information (same VPN

network). Although, as asserted by the Examiner, the sessions may have changed (switch from

one ISP to another), switching sessions (tunnel between ISP and the anchor server) cannot be

similar or in any way suggest switching VPNs. Chuah fails to teach or suggest switching from

one VPN to another. Such a switch results in complete informational lost with respect to the old

VPN. In other words, the information accessed, after the switch occurs, is completely different

(new VPN).

In short, the functionality and the result of the switch from one ISP to another ISP is

completely different from switching between VPNs. In Chuah, when switching between ISPs

(geographical location has changed), the function is to maintain connection for that terminal; the

purpose of Chuah's switch is to maintain connection to the same VPN, to avoid the drop off. In

contrast, the function of switching VPNs is to change connections (log on to a new network) and

the purpose is to provide the user with different information available on a different VPN. In

other words, Chuah attempts to maintain access to the same information, and not switch (force a

disconnect from the previous VPN) to a new VPN. As such, Chuah fails to teach or even

remotely suggest a switch from a second VPN to the first VPN.

In addition, Chuah teaches that the serving LAC notifies anchor LAC that it wants to

connect to VPN and the anchor LAC in turn identifies the LNS of the requested VPN and

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notifies the LNS of the new dial up session. The LNS either accepts or rejects the connection and responds to anchor LAC, which in turn relays it to the serving LAC. However, <u>in Chuah, it is the serving LAC that is connected to the LNS via anchor LAC</u>. Nothing is being done to the LNS to establish the connection with the serving LAC. Chuah only teaches the serving LAC sending messages to the anchor LAC and the anchor LAC sending messages to the LNS and visa versa via same chain.

In short, Chuah fails to teach or suggest <u>changing the configuration of the LNS</u> (one receiving the request) <u>to the configuration of the requester</u>. Applicant respectfully points out that Chuah fails to teach or suggest switching the second terminal, which received a request for a connection. To sum up, Chuah only deals with one VPN. As a result, it fails to teach or suggest switching the second terminal or PC to a different VPN so that the first terminal or PC would access information on this second terminal.

Therefore, switching to a different virtual private network the user terminal to which a request is made, as set forth in claim 1 is not suggested or taught by Chuah, which lacks switching to a second VPN and switching the terminal which received a request for connection, as opposed to switching the requesting terminal. For at least these reasons, Applicant respectfully submits that independent claim 1 is not rendered obvious by Chuah. Applicant, therefore, respectfully requests the Examiner to reconsider and withdraw this rejection of independent claim 1. Also, Applicant respectfully submits that claims 2-5 and 14 are allowable at least by virtue of their dependency on claim 1.

With regard to the independent claims 6, 8 and 10-13, in each, there is some requirement

relating to switching over the VPN of the user terminal. Applicant has already demonstrated that

Chuah does not teach or suggest such a function or feature. Therefore, in view of Chuah, an

artisan of ordinary skill would not have (and could not have) produced the subject matter of any

of these independent claims. Applicant, therefore, respectfully requests the Examiner to allow

claims 6, 8 and 10-13. Claims 7 and 9 are patentable at least by virtue of their dependency on

claim 6.

Improper Finality

A Non Final Office Action issued April 30, 2003, in the above-identified application, in

which claims 1-13 were rejected. Applicant filed an Amendment on July 30, 2003 (hereinafter

"Amendment"), amending claims 1-13 for improved conformity with US practice and improved

clarity and adding claim 14, which did not necessitate additional searches for the Examiner. In

fact, on page 15 of the Amendment, Applicant explained that "the claim amendments are made

solely for the purpose of improved readability and conformance with U.S. practice". In short,

Applicant's response did not **(and could not)** necessitate the new grounds for rejection of claims

1-13. See MPEP § 706.07(a) which states:

> that a second or any subsequent action on
> the merits shall be final, **except** where the
> Examiner introduces a new ground for
> rejection that is: (1) not necessitated by
> an applicant's amendment of the claims or
> (2) based on information submitted in an
> information disclosure statement filed
> during the period set forth in 37 C.F.R. §
> 1.97(c).

In this Office Action dated April 30, 2003 (hereinafter "Office Action"), the Examiner indicated that claims 1-13 are rejected. However, the Examiner indicated that Applicant's arguments with respect to claims 1-13 have been considered but are moot "in view of the new grounds for rejection" (see page 2 of the Office Action). Specifically, in this Office Action, the Examiner rejected claims 1-14 using Chuah, only, as opposed to the previous Office Action dated April 30, 2003, where the Examiner rejected claims 1-13 using Alonso and Chen. In short, in this Office Action, the Examiner provided one new reference, which was not previously made of record.

Therefore, maintaining a final rejection where new rejections are made in the absence of substantive amendments to the claims by the Applicant, is improper. *The improper finality of the Office Action robs the Applicant of the opportunity to respond by amending the claims as of right in the face of prior art references that should have been made of record by the Examiner in the first Office Action.* In view thereof, Applicant respectfully requests the Examiner to withdraw the finality of the Office Action and reopen prosecution for the reason that Applicant's Response under 37 C.F.R. § 1.111 filed July 30, 2003, did *not* necessitate the new grounds of rejection.

Conclusion and request for telephone interview.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue

Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any

overpayments to said Deposit Account.

Respectfully submitted,

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23373
CUSTOMER NUMBER

Date: February 27, 2004

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